

## **REMARKS**

### **I. PRELIMINARY REMARKS**

No claims have been amended, added or canceled. Claims 57-81 remain in the application. Reexamination and reconsideration of the application are respectfully requested.

At the outset, applicant notes that prosecution of this application has become increasingly difficult due to the Examiner's failure to set forth his opinions in an understandable fashion. For example, on page 2 of the Office Action dated July 22, 2004, the Examiner stated that "[t]he specification must be indicated an abandonment immediately." The Examiner also refused to conduct a telephonic interview with applicant's representative to clarify the opinions set forth in an Office Action. This has resulted in a situation where applicant must conduct telephonic interviews with the Examiner's supervisors (who did not participate in the preparation of the Office Actions) in an attempt to understand the Office Actions and, as one might expect, there have been misunderstandings as to the status of the application. Accordingly, applicant respectfully requests that the Examiner have his current supervisor review any subsequent Office Actions in this application prior to mailing (including a review of the Office Action's grammar and substance) in order insure that these problems do not persist.

Applicant wishes to thank the Examiner's current supervisor, Ms. Cynthia Kelly, for the courtesy of the telephonic interviews conducted with the undersigned representative on August 3, 2004 and September 22, 2004. During the August 3, 2004 interview, Ms. Kelly explained that the Examiner objected to the previously presented version of claims 32-56 because the phrase "battery unit" was not preceded by the phrase "portable disposable" in the preamble of some of the claims, and the body some of the claims, as was the case in many of the originally presented claims. Ms. Kelly indicated that this issue could be obviated by submitting a new version of claims 32-56 with the phrase "portable disposable" before the phrase "battery unit" as appropriate. Ms. Kelly also indicated during the August 3, 2004 interview that the minor amendments to the specification and drawings did not

appear to be "new matter" and suggested that applicant provide additional explanation to facilitate the Examiner's understanding of the amendments.

Unfortunately, due to a misunderstanding, applicant's undersigned representative understood Ms. Kelly's comments concerning claims 32-56 to mean that claims 32-56 were not entered and that a substitute set of claims 32-56 should be filed. Apparently, this was not the case and, in response to applicant's August 4, 2004 amendment that included the substitute set of claims 32-56, the Examiner indicated that "[o]ne mayor [sic] mistake after another that [sic] prevents a continuing examination procedure [sic] to go forth ward [sic]." [August 30, 2004 Office Action at page 2.] The Examiner also indicated that both set of claims were rejected under 35 U.S.C. § 112, second paragraph.

In the September 22, 2004 interview, Ms. Kelly indicated that in order to obviate the rejection under 35 U.S.C. § 112, second paragraph, the first version of claims 32-56 would be canceled by the Patent Office and the second version of claims 32-56 would be re-numbered 57-81 by the Patent Office. Ms. Kelly indicated that the remainder of the August 4, 2004 amendment would be considered by the Examiner and that applicant should file remarks in response to August 30, 2004 Office Action in order to insure that applicant's prior comments concerning the amendments to the specification and drawings would be considered and that applicant's discussion of the claims corresponds to the now re-numbered claims.

## **II. AMENDMENTS TO THE SPECIFICATION AND DRAWINGS**

Minor amendments were made to the specification in the August 4, 2004 amendment in order to correct typographical errors and corresponding amendments have been made to the drawings.<sup>1</sup> Clearly, no new matter has been added. Nevertheless, in order to facilitate the Examiner's understanding of the amendments, each correction is discussed in detail below, as it was in the August 4, 2004 amendment.

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<sup>1</sup> The Examiner's attention is directed to MPEP § 2163.07-II, which states that "an amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction." Citation omitted.

In the last sentence of paragraph 00016, “fuel container 220” has been changed to “fuel-battery unit 220” in order to correct a typographical error. The Examiner’s attention is directed to the fact that the phrase “fuel-battery unit 220” appears two other times in the same paragraph. Accordingly, the correction of the typographical error is not new matter.

Both instances of “chamber 220” have been changed to “chamber 225” in paragraph 00017 in order to correct a typographical error. More specifically, and as should be clear from paragraph 00016, reference numeral “220” was also used to represent the fuel-battery unit and a new reference numeral was required to represent the chamber. Thus, the use of reference numeral 225 is not new matter.

Turning to Figure 2, the lead line associated with reference numeral 220 has been extended so as to point to the fuel-battery unit. The Examiner’s attention is directed to paragraph 00016, which clearly indicates that the fuel-battery unit 220 is the device that includes the compartment 208 and the battery 204. Accordingly, the extension of the lead line thereto is not new matter.

Reference numeral 225 and a corresponding lead line have also been added to Figure 2. As discussed above, reference numeral 225 corresponds to the chamber. Paragraph 00017 clearly indicates that the lid 216 in Figure 2 provides access to the chamber and that the fuel-battery unit 220 is inserted into the chamber. One of skill in the art would certainly recognize that such a chamber was shown in Figure 2 as filed. The addition of a reference numeral (here, reference numeral 225) and a corresponding lead line to point to a structural element that was already shown in a figure is not new matter.

### **III. PRIOR ART REJECTIONS**

Claims 1-31 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the U.S. App. Pub. No. 2001/0052433 to Harris (“the Harris ‘433 publication”), U.S. Patent No. 5,976,725 to Gamo (“the Gamo ‘725 patent”) and U.S. Patent No. 6,268,077 to Kelly (“the Kelly ‘077 patent”). [April 5, 2004 Office Action.] As claims 1-31 have been canceled, applicant respectfully submits that the rejection under 35 U.S.C. § 103 has been rendered moot. Nevertheless, in order to

advance prosecution, the patentability of the newly presented claims over these references is discussed in Section VI below.

#### **IV. BRIEF DESCRIPTION OF EXEMPLARY EMBODIMENTS**

The present inventions are generally related to a fuel-battery unit that may be used to supply fuel to a fuel cell and supply power, as needed, to an electrical load. As illustrated for example in Figure 2, a fuel-battery unit 220 in accordance with one embodiment of a present invention includes a container with two compartments – a fuel compartment 208 and a battery compartment for a battery 204. When the fuel-battery unit 220 is connected to the fuel cell system 200, fuel will flow out of the fuel battery unit container (i.e. the container that includes a compartment for fuel **and** a compartment for a battery) to the fuel cell. An electrical connection to the battery 204 will also be made. In the exemplary embodiment illustrated in Figure 2, the fuel and battery connection with fuel-battery unit 220 is made when the fuel battery unit is inserted into the chamber 225.

Turning to Figures 6A-6C, in another exemplary embodiment, the fuel-battery unit includes a container with a compartment for fuel 606 as well as a battery 608 carried by the container. The fuel-battery unit and fuel cell system balance of plant 604 are provided with respective sets of fuel connectors 610 and electrical contacts 612. So arranged, when the fuel-battery unit and fuel cell system balance of plant 604 are connected, the fuel cell stack 602 will receive fuel and the balance of plant 604 will be connected to the battery 608.

#### **V. THE CITED REFERENCES**

The Harris '433 publication is directed to a hybrid power supply module that may be used in place of a conventional battery. Referring to Figure 1, the power supply module 15 includes a battery 1 and a fuel cell 3 located within a common housing 2. Fuel for the fuel cell may be provided by a fuel supply that is located within the housing 2. [Paragraph 0029.] In other words, the battery 1, fuel cell 3 and fuel container (not shown) are all located within the same container, i.e. the housing 2.

The Gamo '725 patent and Kelly '077 patent disclose fuel cell systems that include fuel containers.

## VI. NEWLY PRESENTED CLAIMS 57-81

Newly presented independent claim 57 calls for a combination of elements including, *inter alia*, “a fuel-battery **container including a fuel compartment** having fuel stored therein **and a battery compartment** having a battery stored therein” and “a fuel-battery unit fuel connector, operably connected to the fuel compartment, adapted to be connected to the system fuel connector such that fuel can flow **out of the fuel-battery container.**” In other words, fuel must leave a container that houses **both** the fuel and the battery in order to enter the fuel cell. Independent claims 61 and 68 call for, *inter alia*, related combinations of elements.

The Harris '433 publication fails to teach or suggest such combinations. For example, the only aspect of the Harris power supply module 15 that could arguably correspond to the claimed “container” is the housing 2 because, the separate compartment issue notwithstanding, the housing 2 holds both the fuel and the battery 1. In contrast to the claimed combinations, however, fuel does not exit the Harris housing 2 to enter the fuel cell 3 because the fuel cell is **located within** the housing 2. Applicant respectfully submits that there is nothing in the Gamo '725 patent and Kelly '077 patent to remedy this deficiency. Claims 57-74 are, accordingly, patentable thereover.

Independent claim 75 is directed to “a method of fueling an apparatus that includes a fuel cell and an electrical load connected to the fuel cell.” The method comprises, *inter alia*, the step of “connecting a single fuel-battery cartridge that includes both fuel and a battery to the fuel cell and to the electrical load.” The Harris '433 publication fails to teach or suggest such a combination. For example, the Harris power supply module 15 is not connected to a fuel cell. Instead, it **includes the fuel cell**. Applicant respectfully submits that there is nothing in the Gamo '725 patent and Kelly '077 patent to remedy this deficiency. Claims 75-78 are, accordingly, patentable thereover.

Finally, independent claim 79 calls for a combination of elements including, *inter alia*, "a fuel container including a fuel compartment having fuel stored therein" and "a battery carried by the fuel container." The Harris '433 publication fails to teach or suggest such a combination. For example, the Harris '433 publication, which merely alludes to a fuel supply in the power supply module 15, does not even remotely suggest mounting a battery on a fuel container. Applicant respectfully submits that there is nothing in the Gamo '725 patent and Kelly '077 patent to remedy this deficiency. Claims 79-81 are, accordingly, patentable thereover.

## VII. CLOSING REMARKS

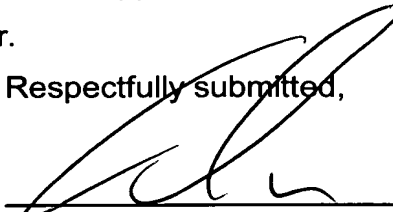
In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 08-2025. Should such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

9/22/04  
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Date

Respectfully submitted,

  
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